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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046185
Party	Plaintiff Amanda Blackhorse, Marcus Briggs, Phillip Gover, Shquanebin Lone-Bentley, Jillian Pappan, and Courtney Tsotigh
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Attachments	Petitioners' Comments on Applicable Law Concerning Disparagement and Laches.pdf (8 pages)(316733 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 1,606,810 (REDSKINETTES)
Registered July 17, 1990,

Registration No. 1,085,092 (REDSKINS)
Registered February 7, 1978,

Registration No. 987,127 (THE REDSKINS & DESIGN)
Registered June 25, 1974,

Registration No. 986,668 (WASHINGTON REDSKINS & DESIGN)
Registered June 18, 1974,

Registration No. 978,824 (WASHINGTON REDSKINS)
Registered February 12, 1974,

and Registration No. 836,122 (THE REDSKINS—STYLIZED LETTERS)
Registered September 26, 1967

Amanda Blackhorse, Marcus Briggs, Phillip Gover, Jillian Papan, and Courtney Tsotigh, Petitioners, v. Pro-Football, Inc., Registrant.	Cancellation No. 92/046,185

PETITIONERS' COMMENTS ON APPLICABLE LAW CONCERNING DISPARAGEMENT AND LACHES

Pursuant to the March 15, 2011 Order ("Order") of the Trademark Trial and Appeal Board's ("Board"), and in advance of the pretrial conference scheduled for April 13, 2011, Petitioners hereby submit their comments on the applicable law concerning disparagement and

laches. For the disparagement issue, Petitioners provide additional legal standards derived from non-*Harjo* authority.

On the issue of laches, Petitioners believe that the D.C. Circuit erred when it rejected the Board's position that the equitable doctrine of laches does not provide a defense in cases in which a petition implicates broad, public policy interests. *See Harjo v. Pro-Football, Inc.*, 30 USPQ2d 1828, 1831 (TTAB 1994); *see also High Sierra Food Servs., Inc. v. Lake Tahoe Brewing Co., Inc.*, Cancellation No. 29,933, 2003 WL 21206252, at *4 (TTAB May 14, 2003) (unpublished) ("The equitable doctrine of laches is not available against a claim of deceptiveness . . . because it is within the public interest to cancel registrations . . . which are deceptive, and this interest or concern cannot be waived by a single person or entity, no matter how long the delay has persisted."). The Board is entitled to deference in its interpretation of the Lanham Act and in how the doctrine of laches applies under the Lanham Act, and the Board is not legally obligated to acquiesce in the D.C. Circuit's decision. Nonetheless, Petitioners respectfully suggest that the Board analyze the defense of laches both under its own *Harjo* standard and under the standard announced by the D.C. Circuit. Doing so will aid the parties in case there is a subsequent action in federal court. Accordingly, Petitioner's comments on the legal standard on laches are offered without waiving their position that the Board's decision on laches in *Harjo* was correct and that the D.C. Circuit erred.

Below, Petitioners suggest certain additions to the discussion of applicable law set forth at pages 3-8 of the Order. The suggested additions are underlined.

A. Disparagement

1. Whether the REDSKINS trademarks "may disparage" Native Americans is a question of fact. *Pro-Football, Inc. v. Harjo,* 284 F.Supp.2d 96, 68 USPQ2d 1225, 1241 (D.D.C. 2003).

2. Petitioners are required to demonstrate by a preponderance of the evidence that the REDSKINS trademarks "may disparage" Native Americans or "bring them into contempt, or disrepute." *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1245. Petitioners are not required to prove that the REDSKINS trademarks do in fact disparage Native Americans, only that the trademarks "may" disparage, *i.e.*, are capable of disparaging. 15 U.S.C. § 1052(a); *see also In re Hines*, 31 USPQ2d 1685, 1686 n.2 (TTAB 1994) (noting that Section 2(a) of Lanham Act merely requires that matter "may" disparage for the mark to be ineligible for registration).

3. Trademarks may disparage if they may "dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison." *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1738. In addition, trademarks may disparage if they may offend the sensibilities of an ethnic or religious group. *In re Lebanese Arak Corp.*, 2010 TTAB LEXIS 68 at *7, 94 US.PQ2d 1215 (TTAB 2010).

4. In deciding whether the matter may be disparaging we look, not to the American public as a whole, but to the views of the referenced group. The perceptions of the general public are irrelevant. *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1739.

5. The views of the referenced group are "reasonably determined by the views of a substantial composite thereof." *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1739. A "substantial composite" may be less than a majority of

the referenced group. *In re Heeb Media, LLC*, 89 USPQ2d 1071, 1077 (TTAB 2008); *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1279 n.12 (TTAB 2006). Competing views or generational divides within the referenced group, or a registrant's good intentions with the use of a mark, are not sufficient to obviate or rebut views of disparagement held by a substantial composite of the referenced group. *Heeb Media*, 89 USPQ2d at 1076-77.

6. To determine the referenced group, the Board will look to "the perceptions of 'those referred to, identified or implicated in some recognizable manner by the involved mark.'" *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1739.

7. The question of disparagement must be considered in relation to the goods or services identified by the mark in the context of the marketplace. *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1739. However, a mark may be generally offensive or disparaging no matter with what goods or services it is used. *Squaw Valley*, 80 USPQ2d at 1277.

8. The test for disparagement comprises a two-step inquiry:

a. What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the goods and services identified in the registrations?

b. Is the meaning of the marks one that may disparage Native Americans?

Pro-Football, Inc. v. Harjo, 68 USPQ2d at 1248; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1740-41.

9. Both questions are to be answered as of the various dates of registration of the involved marks. *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1248; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1735 and 1741 (TTAB 1999).

10. Where a mark has only one pertinent meaning, dictionary evidence alone can create a *prima facie* case of disparagement. *Heeb Media,* 89 USPQ2d at 1075. *See also In re The Boulevard Entertainment,* Inc., 334 F.3d 1336, 67 U.S.P.Q.2d 1475 (Fed. Cir. 2003) (denying trademark registration as scandalous based on dictionary definitions); *In re Tnseltown, Inc.*, 212 U.S.P.Q. 863 (TTAB 1981) (same); TMEP § 1203.01 ("dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, particularly where multiple dictionaries, including at least one standard dictionary, all indicate that a word is vulgar, and the applicant's use of the word is limited to the vulgar meaning of the word").

B. Laches

1. The doctrine of laches runs from the time a party has reached the age of majority. *Pro-Football, Inc. v. Harjo,* 415 F.3d 44, 75 USPQ2d 1525, 1528 (D.C. Cir. 2005).

2. The possibility that respondent may never have security in its registrations because prospective plaintiffs may arise on a regular basis, as they reach the age of majority, does not warrant abandonment of the principle that laches attaches only to those who unjustifiably delay in bringing suit after reaching the age of majority. *Pro-Football, Inc. v. Harjo,* 75 USPQ2d at 1528.

3. When the petitioner in question has brought his/her own claim, there is no reason why the laches of others should be imputed to him/her. *Pro-Football, Inc. v. Harjo,* 75 USPQ2d at 1528.

4. Any particular petitioner's delay, and any resulting prejudice to respondent, both are properly measured based on the period between petitioner's attainment of the age of majority and the filing of cancellation petition. *Pro-Football, Inc. v. Harjo,* 75 USPQ2d at 1528.

5. Pro-Football's laches defense in this case is only available under the common law if Pro-Football proves that (1) the plaintiff Native Americans delayed substantially before commencing their challenge to the "redskins" trademarks; (2) the plaintiff Native Americans were aware of the trademarks during the period of delay; and (3) Pro-Football's ongoing development of goodwill during the period of delay engendered a reliance interest in the preservation of the trademarks (*i.e.,* prejudice to respondent). *Pro-Football, Inc. v. Harjo,* 57 USPQ2d 1140, 1144 (D.D.C. 2000) and 284 F.Supp.2d 96, 68 USPQ2d 1225 (D.D.C. 2003).

6. "[L]aches is not, like limitation, a mere matter of time, but rather turns on whether the party seeking relief "delayed inexcusably or unreasonably in filing suit" in a way that was "prejudicial" to the other party. *Pro-Football, Inc. v. Harjo,* 75 U.S.P.Q.2d at 1528 (internal citations and quotation marks omitted). Prejudice arising during a named plaintiff's period of delay may be prejudice at trial due to loss of evidence or memory of witnesses, and/or economic prejudice based on loss of time or money or foregone opportunity. *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1261.

7. "If only a short period of time elapses between accrual of the claim and suit, the magnitude of prejudice required before suit would be barred is great; if the delay is lengthy, a lesser showing of prejudice is required." *Pro-Football, Inc. v. Harjo,* 565 F.3d 880, 884 (D.C. Cir. 2009) (internal citation and quotation marks omitted).

8. "To be sure, a finding of prejudice requires at least some reliance on the absence of a lawsuit--if Pro-Football would have done exactly the same thing regardless of a more timely complaint, its laches defense devolves into claiming harm not from [Petitioners'] tardiness, but from [Petitioners'] success on the merits." *Pro Football, Inc. v. Harjo,* 565 F.3d at 884.

CONCLUSION

Petitioners respectfully submit that the TTAB incorporate these proposed revisions into its applicable legal standards for this matter.

Respectfully Submitted,

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Dated: April 11, 2011

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on April 11, 2011, he caused a copy of the foregoing Petitioners' Comments on Applicable Law Concerning Disparagement and Laches to be served via email and by first class mail upon the following:

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